

REMARKS

I. STATUS OF CLAIMS

Claims 1-69 are pending. Claims 58-65 and 67 are withdrawn from further consideration pursuant to 37 C.F.R. 1.142(b), as being drawn to a non-elected invention. Claim 39 has been amended to correct the antecedent basis for the term "device." Support for this amendment can be found in claim 38 as filed, the claim from which claim 39 now depends. No new matter has been added by this amendment.

II. PRIORITY

Applicants claim the benefit of U.S. Provisional Application No. 60/507,119 filed October 1, 2003, as indicated in paragraph [001] of the present application. On page 2 of the Office Action, the Examiner requests that Applicants file a certified English translation of the provisional application. In accordance with the Examiner's request, Applicants submit a copy of the electronic filing receipt confirming the filing of the certified translation in U.S. Provisional Application No. 60/507,119.

III. INFORMATION DISCLOSURE STATEMENTS

Applicants thank the Examiner for initialing and returning Form PTO/SB/08 submitted with the Information Disclosure Statement (IDS) filed November 24, 2003.

The Examiner has neither initialed nor returned the IDS Form PTO/SB/08 ("Form") submitted with the IDS filed July 6, 2006. On page 4 of the Office Action, the Examiner states that "the foreign documents have been crossed out since there are no references or abstracts corresponding to references that are not in English." Upon further review, Applicants have determined that the incorrect Form was attached to the IDS filed on July 6, 2006 (the Form attached to the IDS filed on July 6, 2006 was for

U.S. Application No. 10/989,584, filed November 17, 2004, clearly identified at the top of the Form). To correct this error, Applicants attach herewith the correct Form PTO/SB/08 for the above-identified application, which includes the references listed on page 2 of the IDS filed on July 6, 2006. Applicants submit that English language Derwent Abstracts for JP 11-92347 and JP 2002-33222 and English language abstracts for WO 02/30371 and WO 02/30375 were submitted on July 6, 2006. Indeed, the Examiner even indicates that abstracts for JP 11-92347 and JP 2002-33222 were received. See Office Action, at page 4. Further these documents are available on PAIR in the Image File Wrapper (IFW). A copy of the French Search Report for FR 02 15051 was submitted to the Examiner on November 24, 2003. Accordingly, copies are not enclosed. Applicants apologize for this inadvertent error and any inconvenience it may have caused and respectfully request that the Examiner consider the listed documents and indicate that they were considered by making appropriate notations on the attached IDS Form PTO/SB/08.

IV. REJECTIONS UNDER 35 U.S.C. § 112

A. Rejection under 35 U.S.C. § 112, first paragraph

Claims 1-57, 66 and 68-69 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly "failing to comply with the written description requirement." Office Action, at page 4. The Examiner asserts that there is no description in the specification for the species in claim 19 belonging to a dye precursor "chosen from compounds comprising at least one aromatic ring comprising at least two hydroxyl groups borne by two successive carbon atoms of the at least one aromatic ring." *Id.* Applicants respectfully traverse this rejection for at least the following reasons.

There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. M.P.E.P. § 2163; *See also In re Wertheim*, 541 F.2d 257, 263, 191 U.S.P.Q. 90, 97 (CCPA 1976). The Examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. M.P.E.P. § 2163.04. The Examiner has the initial burden of presenting by a preponderance of evidence that Applicants have not complied with the written description requirement. *See id.* To establish a *prima facie* case, the Examiner must provide explicit reasoning why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. *See id.* at § 2163.04(I). "A general allegation of 'unpredictability in the art' is not a sufficient reason to support a rejection for lack of adequate written description." *Id.*

Here, the Examiner has provided only a general allegation, contending that "one skilled in the art would not recognize from the disclosure that the applicant was in possession of the genus drawn to 'all the derivatives recited in claim 19 for the dye precursors.'" Office Action, at page 5. However, the Examiner has not provided any evidence as to why a person skilled in the art would not recognize these derivatives. The Examiner's broad, general statements, with respect to failing to provide adequate description for the genus "derivatives," does not even come close to discharging the burden on the Examiner to establish by a preponderance of evidence that the application, as originally filed, inadequately describes the subject matter in question. After all, the specification is directed to a person of ordinary skill in the art. Accordingly,

Applicants submit that the Examiner has failed to meet her burden of establishing a *prima facie* case with regard to the written description requirement.

Additionally, the Examiner contends that "[t]here is no description for derivatives of 3,4-dihydroxyphenylalanine [and] derivatives thereof, 2,3-dihydroxyphenylalanine [and] derivatives thereof, 4,5-dihydroxyphenylalanine [and] derivatives thereof, 4,5-dihydroxyindole [and] derivatives thereof, 5,6-dihydroxyindole [and] derivatives thereof, 6,7-dihydroxyindole [and] derivatives thereof, and 2,3-dihydroxyindole [and] derivatives thereof." Office Action, at pages 5-6. The Examiner's contention here is completely false. There is literal support in the description at paragraph [051] on pages 11-12 of Applicants' specification for each of the species recited in claim 19. Thus, contrary to the Examiner's contention, based on this disclosure one of ordinary skill in the art would certainly recognize that Applicants were in possession of the genus drawn to "all the derivatives recited in claim 19 for the dye precursors."

Further, Applicants submit that the case law that the Examiner relies on in support of this rejection is not on point and has no bearing on whether Applicants have satisfied the written description requirement under § 112. Specifically, the Examiner cites and discusses *Regents of University of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1569, 43 U.S.P.Q. 2d 1398, 1406 (Fed. Cir. 1997). See Office Action, at page 5. The patent in suit in the *Regents* case relates to the biological arts, in particular recombinant DNA technology. To the contrary, Applicants claimed invention is directed to a chemical composition/product. Thus, the *Regents* case, and its' holding that, "a generic statement which defines a genus of nucleic acids by only their functional activity does not provide an adequate written description of the genus," as stated by the Examiner, is

completely inapplicable in determining whether Applicants have provided adequate written description for the claimed genus. Office Action, at page 5.

As the Examiner points out, "an applicant complies with [the] written description requirement 'by describing the invention, with all its claimed limitation, not that which makes it obvious,' and by using 'such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention.'" Office Action, at page 6 (citing *Lockwood v. American Airline, Inc.*, 107 F.3d 1565, 1572, 41 U.S.P.Q.2d 1961, 1966 (Fed. Cir. 1997) (emphasis added)). Unlike the patentee in *Regents*, in the present application Applicants have provided a structural, not functional description of a number of species falling within the scope of the genus of dye precursors recited in the claims. See, for example, paragraph [051] on pages 11-12 of Applicants' specification. Moreover, the genus itself has been given a structural definition. Accordingly, Applicants have fully complied with the written description requirement.

For at least the foregoing reasons, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

B. Rejection under 35 U.S.C. § 112, second paragraph

Claims 3-11, 19, 33, 39 and 69 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. See Office Action, at page 7.

The Examiner asserts that claims 3-11 are indefinite because "there is no charge for [HCO₃]" recited in these claims. See *id.* Applicants respectfully disagree. As the Examiner points out, one of ordinary skill in the art would understand that bicarbonate is an anion resulting from the deprotonation of carbonic acid, H₂CO₃. See Office Action, at page 7. Indeed, the U.S. Patent Office has previously found the notation [HCO₃] to be

allowable. See claim 1 of U.S. Patent No. 6,953,486 to Pruche ("Pruche"). The Examiner even cites Pruche in a § 103 rejection against the claims of the present application, thus the Examiner, who is arguably one skilled in the art, understood the meaning of HCO_3^- , even though the recitation does not include a charge. Accordingly, contrary to the Examiner's assertions, the subject matter embraced by claims 3-11 is clear and definite.

Additionally, the Examiner asserts that claim 39 is indefinite because there is no antecedent basis for the term "device." See Office Action, at page 7. Claim 39 now depends from claim 38, which provides proper antecedent basis for the term "device."

Further, the Examiner asserts that the expression "derivatives there of (at all occurrences) is without metes and bounds." *Id.* Applicants respectfully disagree with the Examiner's assertion. Breadth of a claim is not to be equated with indefiniteness and this is not an appropriate test for definiteness under the second paragraph of the statute. See *id.* at § 2173.04. If the scope of the subject matter is clear, and if Applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. § 112, second paragraph. *Id.* Stated another way, the test of definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification. Definiteness of claim language should be analyzed in light of: (A) the content of the particular disclosure; (B) the teachings of the prior art; and (C) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. M.P.E.P. § 2173.02. The meaning of the term "derivative" is well-known to one of ordinary skill in the art. Further, claim 19 is

not without metes and bounds because the dye precursors recited in claim 19, including the "derivatives thereof," are species within the parameters of the structural genus recited in claim 1. Therefore, despite the Examiner's contentions, the scope of the subject matter embraced by the claims is clear and definite.

Finally, the Examiner inquires about "the reason for using [a] dye precursor, when the cosmetic product is [a] product for nails, eyebrows, and eyelashes," and requests that Applicants provide "[c]ompetent documentation that the dye precursors are also used for coloring eyebrows, eyelashes, and nails." Office Action, at page 7. First, Applicants would like to clarify for the record that not all the claims are directed to a cosmetic product for nails, eyebrows, and eyelashes. To the contrary, claim 69 is directed to a cosmetic makeup product for nails, eyelashes and/or eyebrows, while claims 1 and 2-57 are directed to a coloring composition for a keratin material, claim 66 is directed to a hair coloring product, and claim 68 is directed to a cosmetic skin makeup product.

Turning to the Examiner's inquiry, Applicants submit that cosmetic products are for coloring, and thus a dye or a dye precursor would be used in a cosmetic product, including a product for nails, eyebrows, and eyelashes, to provide such coloring. Accordingly, Applicants submit that one of ordinary skill in the art would readily understand the reason for using dye precursors in cosmetic products without the requested documentation, and thus the requested documentation has not been provided.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw the § 112, second paragraph rejections.

V. REJECTIONS UNDER 35 U.S.C. § 103

A. Rejection under 35 U.S.C. § 103(a) over U.S. Patent No. 6,953,486 to Pruche and U.S. Patent No. 6,736,861 to Patel et al.

Claims 1-41, 50-53, 66 and 68-69 are rejected under 35 U.S.C. § 103(a) as allegedly "being obvious over" the combination of U.S. Patent No. 6,953,486 to Pruche ("Pruche") and U.S. Patent No. 6,736,861 to Patel et al. ("Patel"). Office Action, at page 8.

The Pruche patent issued on October 11, 2005 and was filed on October 9, 2001. The present application was filed on November 24, 2003. Therefore, the Pruche patent only constitutes prior art under 35 U.S.C. § 102(e) against the claims of the present application.

As amended by the American Inventors Protection Act of 1999 ("AIPA"), § 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more subsections of (e), (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. (emphasis added).

Further, M.P.E.P. § 706.02(I)(1) states:

Enacted on November 29, 1999, the American Inventors Protection Act (AIPA) added subject matter which was prior art under former 35 U.S.C. § 103 via 35 U.S.C. § 102(e) as disqualified as prior art against the claimed invention if that subject matter and the claimed invention 'were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.' The 1999 change applied to all utility, design and plant patent applications filed on or after November 29, 1999. (Emphasis added) (citations omitted).

Pruche and the instant application were subject to an obligation of assignment to L'Oréal S.A. at the time the presently claimed invention was made, as evidenced by the assignment information recorded for the Pruche patent on October 30, 2002, at Reel 013445, Frame 0023 and the assignment information recorded for the instant application on April 19, 2004, at Reel 015229, Frame 0864. Thus, Pruche cannot be prior art against the present application under 35 U.S.C. § 103(a).

Applicants further note that the application that issued as the Pruche patent previously published as U.S. Publication No. 2003/0163878 on September 4, 2003. However, the present application claims the benefit to French application, FR 02 15051, filed November 29, 2002, which precedes the publication date of U.S. Publication No. 2003/0163878. Applicants submit herewith a certified English-language translation of their foreign priority document, FR 02 15051, to perfect their claim to priority and remove the Pruche publication as a possible prior art reference relative to the claims of the present application.

Additionally, as discussed above, any rejection under 35 U.S.C. § 103(a) based on § 102(e) prior art is subject to the conditions of § 103(c). Therefore, for at least the same reasons as discussed above, the Pruche publication cannot qualify as legally valid prior art in support of a rejection under 35 U.S.C. § 103(a).

In view of the foregoing, Applicants respectfully request that the Examiner withdraw the § 103(a) rejection of claims 1-41, 50-53, 66 and 68-69 over the combination of Pruche and Patel as the Pruche patent and its publication are not valid prior art under any section of 35 U.S.C. § 102.

B. Rejection under 35 U.S.C. § 103(a) over WO 02/30375 to Pruche and U.S. Patent No. 6,736,861 to Patel et al.

Claims 1-41, 50-53, 66 and 68-69 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over the combination of WO 02/30375 to Pruche and U.S. Patent No. 6,736,861 to Patel et al. ("Patel"). Office Action, at page 9. The Examiner points out that U.S. Patent No. 6,953,486 to Pruche ("Pruche") is the English equivalent of WO 02/30375 and the Examiner is relying on the disclosure of Pruche in this rejection. *Id.* The Examiner admits that Pruche fails to teach a composition having an acidic composition or a basic composition. *See id.* at page 10. The Examiner turns to Patel to supplement the deficiencies of Pruche. The Examiner asserts that Patel teaches coloring hair using an acidic and basic composition. *See id.* The Examiner asserts that "it would be obvious to one of ordinary skill in the art at the time the invention was made" to add the acidic and basic compositions of Patel to the hair coloring compositions disclosed in Pruche because "it is *prima facie* obvious to combine two compositions which have been used individually for the same purpose since the idea of combining the ingredients flows logically from the art." *Id.* at page 10. Applicants respectfully disagree and traverse this rejection for at least the following reasons. All citations to Pruche refer to U.S. Patent No. 6,953,486.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *See* M.P.E.P. § 2142. In *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q. 2d 1385 (2007), the Supreme Court confirmed that the "framework for applying the statutory language of §103" was still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 148 U.S.P.Q. 459

(1966). Under *Graham*, there are four factors for consideration when determining whether an invention is obvious:

- (1) the scope and content of the prior art;
- (2) the differences between the prior art and the claims at issue;
- (3) the level of ordinary skill in the art; and
- (4) secondary considerations.

383 U.S. at 17, 148 U.S.P.Q. at 467. Although the question of obviousness must be resolved on the basis of these factual determinations, the Supreme Court pointed out that there is no inconsistency between the *Graham* analysis and the idea underlying the teaching, suggestion, or motivation ("TSM") test. *KSR*, 127 S. Ct. at 1741, 82 U.S.P.Q. 2d at 1389. Further, in its recent published examination guidelines, the USPTO has solidified that the TSM test is a valid rationale for determining obviousness. See M.P.E.P. § 2141(III)(G).

Patel discloses a daily hair care composition comprising a mixture of two compositions, part A and part B. See Patel at col. 3, lines 10-11. According to Patel, Part A is dye intermediates in a conditioner or shampoo base at alkaline pH and Part B is hydrogen peroxide in a conditioner or shampoo base at acidic pH. *Id.* at col. 3, lines 12-15 (emphasis added). As discussed above, the Examiner asserts that it would have been obvious to add the hair care composition of Patel comprising a mixture of an acidic composition and a basic composition to the hair coloring compositions disclosed in Pruche to arrive at Applicants' claimed invention. See Office Action, at page 10. However, in Applicants' view, Pruche actually teaches away from such a combination. The coloring compositions disclosed in Pruche "have the advantage of not requiring the

use of hydrogen peroxide." Pruche at col. 8, lines 19-20 (emphasis added). One of ordinary skill would not have a reason to include the composition disclosed in Patel, comprising two components, one of which contains hydrogen peroxide, in the coloring compositions as disclosed by Pruche. Prior art must be considered in its entirety, including disclosures that teach away from the claims. M.P.E.P. §§ 2141.02(VI). Indeed, the Federal Circuit has repeatedly recognized that proceeding contrary to the accepted wisdom in the art represents "strong evidence of unobviousness." *In re Hedges*, 783 F.2d 1038, 1041, 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986). Thus, the predominantly negative (i.e., regarding use of hydrogen peroxide) disclosure of Pruche cannot justifiably be considered support for a *prima facie* case of obviousness.

Additionally, paragraphs [013]-[014] of Applicants' specification discusses the coloring agent of Pruche ((WO 02/30375) and how the claimed invention has improved upon the coloring agent described therein.

In view of the foregoing, Applicants submit that the rejection under 35 U.S.C. § 103(a) is in error and should be withdrawn.

VI. DOUBLE PATENTING REJECTION

Claims 1-41, 50-53, 66 and 68-69 are rejected for obviousness-type double patenting over claims 1-32 of U.S. Patent No. 6,953,486 to Pruche ("Pruche") in view of U.S. Patent No. 6,736,861 to Patel et al. ("Patel"). Office Action, at page 11. The Examiner asserts that claims 1-41, 50-53, 66 and 68-69 are not patentably distinct from claims 1-32 of Pruche in view of Patel for the reasons set forth regarding the § 103 rejection over the combination of these references discussed above.

Prior art must be considered in its entirety, including disclosures that teach away from the claims. M.P.E.P. §§ 2141.02(VI). As discussed above, Pruche teaches away from including a hydrogen peroxide component, as required by Patel, in a coloring composition. Accordingly, for at least the reasons discussed above, the claimed invention would not have been *prima facie* obvious over the combination of Pruche and Patel.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw the obviousness-type double patenting rejection.

VII. CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 11, 2008

By: Jennifer R. Leach
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Attachments: Corrected IDS Form PTO/SB/08

**Electronic filing receipt confirming filing of certified translation
in U.S. Provisional Application No. 60/507,119**

**English-language translation of foreign priority document,
FR 02 15051**